

Remarks

Claims 1-5, 7-12 and 14-21 are pending in the application. Claims 1, 8 and 16-21 have been amended. Claims 6 and 13 were previously canceled. New claims 22-23 have been added.

I. Rejection Under 35 U.S.C. §112, Second Paragraph

Claims 16-21 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 16-21 have now been amended to place dependency on method claim 15. Claims 16-21 are now believed to be acceptable with respect to this objection.

II. Rejections Under 35 U.S.C. §103(a)

The Examiner has rejected all of Applicant's pending claims as being obvious under §103(a), based solely upon the reference Gibson (U.S. Patent No. 2,883,940).

Applicant respectfully submits that the reference cited and relied on by the Examiner does not provide a *prima facie* case of obviousness of the presently pending claims.

In order to establish a *prima facie* case of obviousness, the prior art references must teach or suggest all of the claim limitations when combined. See *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974); and MPEP 2143.03.

With respect to Gibson, the Examiner states that the "adaptor 18 engages the inner and outer conduits at the other end of the conduits... [and] prevents lateral movement but allows relative longitudinal movement between the inner and outer conduits regardless of how the force is applied (i.e. compression or tension).

Applicant respectfully disagrees with this statement. Nothing in Gibson discloses, teaches or suggests that longitudinal movement of outer and inner conduits is allowed in the device of Gibson. In fact the only description of the packing gland 18, which the Examiner contends constitutes an adaptor, is set forth in the paragraph at column 2, lines 6-22, where it states:

there is an inwardly extending internal annular recess 16 from which there is an inwardly extending threaded portion 17 for reception of a packing gland 18 having a[n] axial passage 19 therethrough in which is received the upper end portion of a pipe 20 having an external diameter smaller than the internal diameter of the pipe 13. Inwardly of the threaded portion 17 of the collar, there is an annular recess 21 in which is disposed packing 22 of any suitable well-known character and between the packing 22 and the packing gland is a washer. A seal 24 is disposed in an annular groove provided in the collar adjacent the inner end of the portion 17 to thereby provide a seal between said collar and the inner end of the packing gland. (Col. 2, lines 10-23).

Nowhere in the text, as set forth above, is it described that any longitudinal movement is allowed. The Examiner is merely attributing a property or characteristic that may occur within the Gibson reference, but which is not expressly shown or described. Applicant respectfully submits that it is improper to attribute a property or characteristic of the device that is not shown or described, but can only be derived through a strained interpretation of the reference that could only be made in hindsight. There is nothing that indicates that the pipe 20 is movable longitudinally with respect to the gland 18 within the passage 19. And because the gland 18, which the Examiner contends constitutes an adaptor, is threaded into the collar 15 via threads 17, no longitudinal movement from compression or tension forces would be allowed between the collar 15 and gland 18.

Furthermore, one skilled in the art encountering this early reference from 1957 would not be apprised of an adapter that allows longitudinal movement, as set forth in Applicant's claims.

First, the failure of Gibson to discuss or disclose the relative longitudinal movement between pipe 20 and collar 15 and the particular advantages this would provide supports the position that no such movement is permitted in the device of Gibson. This is an important advantage that has not been addressed in the prior art devices, as discussed in Applicant's background section. If such movement were permitted by the device of Gibson, this would have been a significant advantage and would likely have been disclosed or addressed.

Additionally, as shown in the relevant portions of the Gibson device, from Figure 1, as set forth below, the Gibson device includes a partition 26, which appears to directly

abut against the pipe 20. This in itself may prevent longitudinal movement of the pipe 20. Additionally, the packing material 22 may be of a nature and character such that the packing material 22 firmly grasps the pipe 20, particularly when compressed, so that longitudinal movement of the pipe 20 is prevented. This is no different than the packer 50 that would anchor the tubing string within the casing 10, while providing a seal therebetween and would be similar to the packing assembly 72 discussed at paragraph 0022 of Applicant's specification.

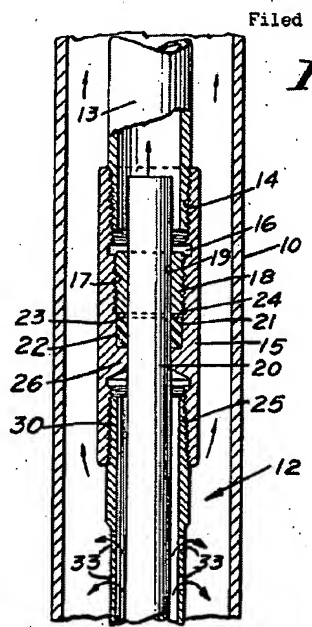


Figure 1 of Gibson

Furthermore, one skilled in the art encountering Gibson would understand that the pipe 20 is tightly held within the packing gland 18, which would prevent longitudinal movement. This is because in Gibson the described seal 24 that engages the packing gland 18 is only provided to seal the annular spaces between the collar 15 and the packing gland 18. As described at column 2, lines 19-22, a seal 24 is received within an annular groove provided in the collar 15 to provide a seal between the collar and the inner end of the packing gland 18. It thus appears that in addition to the seal created by the packing 22, sealing is also required between the packing gland 18 and the collar 15. No seal, however, is provided at the inner portion of the gland 18 where the gland 18 engages the pipe 20. To maintain a fluid seal between the gland 18 and exterior of the inner pipe

20, while permitting longitudinal movement relative to the gland 18, one skilled in the art encountering this reference would understand that another seal (like the seal 24) would be required between the gland 18 and pipe 20 to prevent fluid seepage to or from passage 16. No such seal is shown or described, however.

One skilled in the art would therefore believe that the gland 18 may be welded or otherwise fixed in a manner to the pipe 20 that would provide sealing engagement between the gland 18 and pipe 20, and would not allow any longitudinal movement. Such a construction is consistent with Applicant's knowledge of the prior art. Indeed, such welding that provides sealing engagement was described in Applicant's specification at paragraph 0003 for the prior art plate or annular ring 14 (Fig. 1) that is welded to the interior of the tube 16.

Applicant acknowledges that the packing 22 may provide sealing of the space between the collar 15 and pipe 20, as is described in Gibson. This, however, is provided because Gibson allows for removability of the pipe 20 from the collar 15. Nowhere is it described that the pipe 20 is removable or movable from the packing gland 18, however. Removability of the pipe 20 from the collar 15 is also consistent with the pipe 20 being rigidly secured or tightly held within the gland 18, as removal of the pipe 20 can be accomplished by unthreading the gland 18 with the pipe 20 secured therein.

For all of these reasons set forth above, Applicant submits that Gibson fails to provide a *prima facie* case of obviousness as Gibson fails to disclose, teach or suggest an adaptor that engages the inner and outer conduits at a second end to prevent lateral movement of the second end of the inner conduit within the outer conduit while allowing relative longitudinal movement of the outer and inner conduits. Accordingly, all of Applicant's pending claims should be allowed.

Claims 2, 9 and 17 should be allowed for the additional reason that Gibson fails to disclose an adaptor that provides sealing engagement between inner and outer conduits. As described above, a seal 24 is provided for providing a seal between the packing gland 18 and collar 15. No seal is provided between the packing gland 18 and pipe 20, however. Applicant submits that only if the pipe 20 is rigidly secured within the packing gland 18, such as by welding or otherwise, would such a seal be provided. This would prevent longitudinal movement of the pipe within the packing gland, however. Claims 2,

9 and 17 should therefore be allowed as depending upon an allowable base claim or because Gibson fails to fairly teach or suggest this feature.

With respect to independent claim 8, Applicant has further amended this claim to call for the second end of the outer tubular conduit to be smooth bored, as is shown in Figure 2. The packing gland 18, which the Examiner contends constitutes an adaptor, is configured for engagement and cooperation with a collar 15 that includes threaded portion 17, an annular groove for receiving seal 24, as well as inwardly projecting partitions 26, to provide the necessary function and cooperation. Applicant's claimed device can be used with a smooth bored outer conduit and is much simpler in design and requires fewer components than the device of Gibson. For this additional reason independent claim 8 and those claims depending from it should be allowed.

Applicant is submitting new claims 22 and 23. Claims 22 and 23, as well as previously amended independent claim 15, require that the second end of the inner conduit be threaded and wherein the adaptor has corresponding threads for securing the adaptor to the second end. The Examiner had originally indicated, in the Office Action dated September 8, 2005, that this limitation constituted allowable subject matter.

The Examiner has acknowledged that Gibson fails to disclose the feature of the packing gland 18 being threaded to the inner member. It is the Examiner's current position that it would be an obvious reversal of parts to thread the packing gland 18 to the inner member as opposed to the outer member since it will perform its function equally well when threaded to the outer or inner member. Applicant respectfully disagrees with this statement.

Applicant would point out that if the Examiner is of the opinion that the pipe 20 is longitudinally movable within the packing gland 18, then threading of the packing gland 18 to the inner member or pipe 20 would destroy the intended purpose or function of the device of Gibson. The purpose of the packing gland 18 is to compress or retain the packing 22 against the partition 26. In this configuration, the pressure or force exerted against the packing 22 remains generally constant because there is no relative movement of the packing gland 18 relative to the partition 26. Coupling the packing gland 18 to the inner member or pipe 20, as the Examiner suggests, would allow the packing gland to rise and fall relative to the partition 26, so that the packing 22 material is further

compressed or relaxed, thus likely damaging the packing 22 or destroying the integrity of the seal provided by the packing 22. Accordingly, Applicant submits that Gibson, in combination with the Examiner's assertion, fails in establishing a *prima facie* case of obviousness. For these additional reasons, Applicant submits that claims 15, 22 and 23 are allowable.

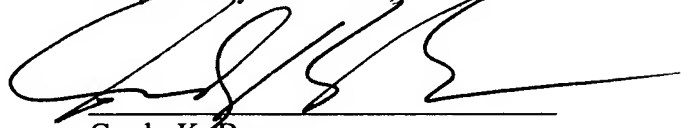
In view of all of the reasons presented above, Applicant submits that the application is in a condition for allowance. Favorable action is therefore respectfully requested.

No fees are believed necessary for this response. This response is being submitted within three months from the date of the office action. If any extension of time is believed necessary, however, such extension is hereby requested. If any fees are deemed necessary for the continued prosecution of the present application, the Commissioner is hereby authorized to charge them to Deposit Account No. 50-1899.

Please contact the undersigned at the address or telephone number listed below should there be any questions, or if contacting the undersigned would expedite or aid the examination or prosecution of this application.

Date: April 10, 2006

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Grady K. Bergen', written over a horizontal line.

Grady K. Bergen
Reg. No. 37,587
Customer No. 27883
3333 Lee Parkway, Suite 600
Dallas, Texas 75219
(214) 665-9568
(214) 665-9572 Facsimile

ATTORNEY FOR APPLICANT